



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/841,038

04/25/2001

Fujio Morita

1614.1163

6609

21171

7590

08/10/2006

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

FLEURANTIN, JEAN B

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/841,038	MORITA, FUJIO	
	Examiner	Art Unit	
	JEAN B. FLEURANTIN	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This in response to Applicant's arguments submitted on 05/12/06.

Claims 1-12 remain pending for examination.

Response to Applicant' Remarks

Applicant's arguments submitted on 05/12/06 have been fully considered but they are not persuasive for the following reasons, see sections A and B.

Claim Rejections - 35 USC § 103

- A. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Related Art "specification pages 1-5, up to lines 2 and Figs 1, 2(A-D) and 3(A-B)" ("Related Art") in view of U.S. JP No. 10031683A issued to Kurosawa Haruhiro ("Haruhiro").

As per claim 1, Related Art discloses "implemented in a client computer a search unit that determines a hierarchical category of an address designated for registration based on a definition entry and a selection record of a menu" (i.e., three search engines and categorized (hierarchical) type, see figure 1, page 2, lines 26-32); and

"a registration unit that registers an address in the category" (i.e., list registered bookmarks; see Figs 1-3A, element S 16, page 3, line 30 to page 4, line 19),

"wherein predefined search information is registered for each category" (see page 4, lines 31-34),

"wherein, when a new keyword is search for by using a combination of a plurality of upper level keywords, the registration unit generates a lower level category corresponding to the new keyword" (see page 2, line 18-33), and "registers the lower level category in a manner to be linked to an upper level category" (see page 2, lines 18-25). Related Art fails to explicitly disclose a search support device in which an address indicating a location of information accessible on a network is registered; which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network. However, Haruhiro discloses a search support device, the device comprising: an address indicating a location of information accessible on a network is registered; and which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network (see page 17, paragraph [0040]).

It would have been obvious to a person of ordinary skill in the art to modify the teachings of Related Art with a search support device, the device comprising: an address indicating a location of information accessible on a network is registered; which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network as disclosed by Haruhiro (see Haruhiro Figs. 1 and 4 and corresponding paragraphs). Such a modification would allow the teachings of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of World Wide Web servers connected to a W W W (see Haruhiro abstract).

As per claim 2, Related Art discloses "wherein the registration unit registers the address designated for registration in the category containing the registered address the registered address when located at the same level as the address designated for registration" (see page 2, line 18-33).

As per claim 3, in addition to claim 1, Related Art discloses "determining a category of an address designated for registration based on a definition entry and a selection record of a menu" (see page 4, line 11 to page S, line 2).

As per claim 4, in addition to claim 1, Related Art discloses "a category menu storage unit that stores a category menu in which predetermined categories are listed up" (i.e., the information including the URL address of each registered homepage is registered as the list of registered bookmarks; see figure 3, page 4, lines 15-19).

As per claim 5, in addition to claims 1 and 3, Related Art further discloses "a display unit that displays an address in another form indicating the location of desired information detected based on the search information generated by the search information generating unit" (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 6, Related Art further discloses "an address selection unit that selects the address registered in the category menu so as to make an access to the location of the desired information" (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 7, Related Art discloses "an icon conversion unit that visually changes the category in which the address is registered by the address registration unit" (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 8, in addition to claim 1, Related Art discloses "storing a category menu in which predetermined categories are listed up" (i.e., the information including the URL address of each registered homepage is registered as the list of registered bookmarks; see figure 3, page 4, lines 15-19).

As per claim 9, in addition to claim 1, Related Art discloses "a recording medium which stores a program for a computer to perform an operation" (see Figs. 1 to 3B, page 2, lines 26-33),

"a procedure for classifying the address in accordance with a category related to information that can be accessed at the address" (see page 4, line 11 to page 5, line 2); and

"a procedure for registering the address classified in accordance with the category" (i.e., using a search engine to obtain desired information, and categorized (hierarchical) type, see page 1, lines 27-34).

As per claim 10, in addition to claim 1, Related Art discloses "a recording medium which stores a program for a computer to perform an operation" (see Figs. 1 to 3B, page 2, lines 26-33),

"a procedure for generating search information associated with a category selected from the category menu" as the information including the URL address of each registered homepage is registered as the list of registered bookmarks, (see figure 3, page 4, lines 15-19); and

"a procedure for registering the address classified in accordance with the category" (see Figs 1-3A, element S 16, page 3, line 30 to page 4, line 19).

As per claim 11, Related Art discloses "wherein the program further includes a procedure for generating the category menu" (see Figs. 3(A and B)).

As per claim 12, Related Art discloses "a method, implemented in a client computer" (see page 1, line 35 to page 2, line 1), the method comprising:

"a searching for the address of the desired information based on the registered predetermined search information when hierarchical category is selected" (i.e., using a search engine to obtain desired information, and categorized (hierarchical) type, see page 1, lines 27-34); and

"wherein, when a new keyword is search for by using a combination of a plurality of upper level keywords, the registration unit generates a lower level category corresponding to the new keyword" (see page 2, line 18-33), and "registers the lower level category in a manner to be linked to an upper level category" (see page 2, lines 18-25). Related Art fails to explicitly disclose for searching for an address of desired information on a network based on search information associated with the desired information; which registering predetermined search information on the network for each of a plurality of hierarchical categories into which information is classified. However, Haruhiro discloses for searching for an address of desired information on a network based on search information associated with the desired information; which registering predetermined search information on the network for each of a plurality of hierarchical categories into which information is classified (see Haruhiro page 17, paragraph [0040]).

It would have been obvious to a person of ordinary skill in the art to modify the teachings of Related Art with for searching for an address of desired information on a network based on search information associated with the desired information; which registering predetermined search information on the network for each of a plurality of hierarchical categories into which information is classified as disclosed by Haruhiro (see Haruhiro Figs. 1 and 4 and corresponding paragraphs). Such a modification would allow the teachings of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of world wide web servers connected to a W W W (see Haruhiro abstract).

B. In response to applicant's argument, page 6, paragraph 2, independent claim 1 has amended to recite that "when a new keyword is searched for by using a combination of a plurality of upper level keywords, the registration unit generates a lower level category corresponding to the new keyword, and registers the lower level category in a manner to be linked to an upper level category." Applicant respectfully submits that neither the "Related Art" nor Haruhiro teaches or suggests this feature. Independent claims 3, 4, 8, 9, 10, and 12 have been similarly amended." The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Related Art fails to explicitly disclose a search support device in which an address indicating a location of information accessible on a network is registered; which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network. Haruhiro discloses a search support device, the device comprising an address indicating a location of information accessible on a network is registered; and which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network (see Haruhiro page 17, paragraph [0040]). It would have been obvious to a person of ordinary skill in the art to modify the method of Related Art with a search support device, the device comprising an address indicating a location of information accessible on a network is registered; which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network as disclosed by Haruhiro (see Haruhiro Figs. 1 and 4 and corresponding paragraphs). Such a modification would allow the method of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of World Wide Web servers connected to a W W W (see Haruhiro abstract).

In response to applicant's argument, page 7, paragraph 3, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a search unit that determines a hierarchical category of an address designated for registration based on a definition entry and a selection record of a menu") are not recited in the rejected claims 3, 4, 8, 9, 10 and 12. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

MPEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater*, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In *re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the last Office Action was proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

CONTACT INFORMATION

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 - 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 - 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jean Bolte Fleurantin

Patent Examiner

Technology Center 2100

August 4, 2006


SHAHID ALAM
PRIMARY EXAMINER